

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON T. EPPS, DAN L. TERRY and JACKSON G. WEAVER



Appeal No. 2005-1987
Application No. 09/004,803

ON BRIEF

Before WARREN, WALTZ, and KRATZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 5, 7, 9, 12, 16, 18 and 19. Claims 13 through 15 are the only other claims pending in this application.¹ We have jurisdiction pursuant to 35 U.S.C. § 134.

¹The examiner has stated that claims 13 through 15 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, ¶2 (final Office action dated Mar. 26, 2003, page 4). We note that claims 13-15 were also the subject of a rejection under 35 U.S.C. § 112, ¶1, but this rejection was not mentioned by the examiner in the discussion of allowable subject matter (*id.* at page 2). The examiner has withdrawn the rejection of claims 13-15 under the second paragraph of section 112, as well as the rejection of claims 13-15 under the first paragraph of section 112 (Answer, page 3). However, despite the withdrawal of these rejections, the examiner is silent as to the status of claims 13-15. Since these claims are not the subject of any rejection, we will not consider claims 13-15 to be on appeal. Upon the return of this application to the jurisdiction of the examiner, the status of claims 13-15 should be clarified.

According to appellants, the invention is directed to a motor-operated fast-food service window with upwardly focused proximity detectors (Brief, page 2). Representative independent claims 1 and 2 are reproduced below:

1. A fast-food service window comprising:
a window assembly with at least one movable window member;
a window operator assembly mechanically coupled to the movable window member;

an upwardly focused proximity sensor comprising an emitter emitting radiation and a receiver receiving radiation from the emitter, said radiation being reflected from an object being sensed, said sensor being focused upward at an angle slightly askew of a vertical axis and functionally coupled to the window operator assembly and directed to detect an extended arm of a person when said arm is extended over said proximity sensor;

wherein the movable window member opens whenever said extended arm of said person is sensed by said proximity sensor.

2. A fast-food service window comprising:
a window assembly with at least one movable window member;
a window operator assembly mechanically coupled to the movable window member;

a plurality of upwardly focused proximity sensors, each of said sensors comprising an emitter emitting radiation and a receiver receiving radiation from the emitter, said received radiation being reflected from an object being sensed, said sensors being focused upward at an angle that deviates from a vertical axis by not more than about 10° and functionally coupled to the window assembly and directed to open the movable window member in response to said proximity sensors.

In addition to the admitted prior art as evidenced by appellants' Figure 5, the examiner has relied on Jönsson (hereafter Jonsson), U.S. Patent 4,560,912, issued Dec. 24, 1985, as evidence of obviousness.

Claims 2-4, 7, 9, 18 and 19 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to meet the written description requirement (Answer, page 3, referring to the Office action dated Oct. 22, 2002). Claims 1, 5, 12 and 16 stand rejected under 35 U.S.C. § 103 as unpatentable over the admitted prior art of Figure 5 in view of Jonsson (*id.*).²

Based on the totality of the record, including due consideration of the opposing arguments presented in the Brief and the Answer, we reverse all rejections on appeal essentially for the reasons stated in the Brief and those reasons set forth below.

OPINION

A. The Rejection based on § 112, ¶1

The examiner finds that "[t]he specification does not provide explicit or inherent support for the sensor being focused

²As previously noted, the examiner has withdrawn the rejection in the final Office action of claims 1-5, 7, 9, 12-16, 18 and 19 under the second paragraph of section 112, as well as withdrawn claims 13-15 from the rejection based on section 112, first paragraph (Answer, page 3).

upward at an angle that deviates from a vertical axis by not more than about 10 degrees" (Answer, page 3). The examiner finds that the specification does disclose the broad range of "upwardly focused sensors" and the specific example of the sensors angled approximately 10 degrees from the vertical axis (*id.*). Therefore the examiner concludes that appellants did not have possession of the limitation in question, i.e., not more than about 10 degrees (Answer, pages 3-5). The examiner further states that appellants also were not in possession of angling the sensors outwardly toward the service window, which is included in the claim language in question (Answer, page 5).

Appellants admit that the language recited in claim 2 on appeal ("an angle that deviates from the vertical by not more than about 10°") is not found explicitly in the original specification (Brief, pages 7 and 9). However, the written description requirement can be fulfilled even when the contested language does not *ipsis verbis* appear in the original disclosure. See *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996), citing *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). The written description requirement of the first paragraph of section 112 is fulfilled if the specification would have reasonably conveyed to one of

ordinary skill in the art that, at the time of filing the application, appellants were in possession of the contested claimed subject matter. See *In re Edwards, supra*.

The examiner and appellants agree that the original specification and claims disclose that the proximity sensors can be "upwardly focused" with a preferred embodiment at an angle "slightly askew of the vertical axis," or at an angle α of approximately 10 degrees (Answer, page 3; Brief, page 10; specification, page 7, ll. 4-5, and page 8, ll. 8-12). Contrary to the examiner's interpretation (Answer, page 4), we do not find the broad range disclosed by appellants in the original specification to be "vague" ("upwardly focused" or, as the examiner phrases it, "upwardly pointing"). We determine "upwardly focused" to have its plain and ordinary meaning where sensors are focused to provide a beam of radiation at any degree upward or greater than the "horizontal" axis (compare Figure 4 with the "prior art" in Figure 5; see also the specification, page 8). Therefore we determine that appellants would have reasonably conveyed to one of ordinary skill in the art that they were in possession of the sensors being focused from zero to some angle less than 90 degrees from the vertical axis, with a specific example of an angle of about 10 degrees (see the Brief,

page 8). Accordingly, we therefore determine that a range within appellants' broad range (i.e., the range of "not more than about 10 degrees") would also have been reasonably conveyed to one of ordinary skill in the art. See *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976).

We also cannot sustain the examiner's rejection based on "outwardly" pointing sensors (Answer, page 5). As stated by the examiner, such sensors would not operate or achieve appellants' result (*id.*) and thus could not be construed to be within the scope of the claims (see the specification, page 4, ll. 7-8). Accordingly, such description is not required in the original specification.

For the foregoing reasons and those set forth in the Brief, we cannot sustain the examiner's rejection of claims 2-4, 7, 9, 18 and 19 under 35 U.S.C. § 112, first paragraph.

B. The Rejection under § 103(a)

The examiner finds that the admitted prior art as shown in appellants' Figure 5 discloses a fast food service window having horizontally focused sensors 60 and 62 (Answer, page 5). The examiner applies Jonsson for the disclosure of upwardly focused sensors 10 that are focused at an angle "slightly askew from a vertical axis" (Answer, page 6). The examiner concludes that it

is "clearly reasonable for one with ordinary skill in the art to replace the well known sensors 60 and 62 of the admitted prior art in figure 5 with the well known sensors 10 of Jonsson to more rapidly operate the window when a worker approaches." *Id.* The examiner concludes that because the sensors 10 of Jonsson are focused upwardly and outwardly, they would detect an approaching worker "significantly before" the horizontally placed sensors of the admitted prior art in Figure 5. *Id.*

The initial burden of establishing the prima facie obviousness of the claimed subject matter rests with the examiner. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere simplicity of the claimed invention or less complex technology involved does not affect the question of obviousness nor allow the use of hindsight. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The question is not whether the individual elements of the claims were known in the art but whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); see also

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Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.,
730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

As correctly argued by appellants, their invention lies in the recognition of the source of a problem, namely the detection of the presence of product or arms of an attendant near an automatic window has a greater correlation to the desired state of the window than does the torso or center of mass [i.e., use of horizontal sensors] of the attendant (Brief, page 16). We agree with the examiner (Answer, page 6) that Jonsson discloses sensors 10 angled at approximately 30 degrees from the vertical in order to orient the elevation radiation beam "in a slightly upward from horizontal" direction (col. 6, ll. 64-68; see also Figure 4). However, Jonsson discloses these sensors 10 "mounted approximately 15" above the floor on door 30 to detect objects near the bottom of the door." Col. 7, ll. 3-5. The examiner has not convincingly established why one of ordinary skill in this art would have desired the replacement of well known sensors 60 and 62 used with a *window* of the admitted prior art with the upwardly focused sensors 10 used with the *door* of Jonsson, absent the hindsight of knowing the problem and solution advanced by appellants in their specification and claims. See *In re Dembiczak, supra*. The only motivation or desirability set forth

by the examiner (Answer, page 6) presumes knowledge of appellants' source of the problem and solution.

For the foregoing reasons and those stated in the Brief, we determine that the examiner has failed to establish a prima facie case of obviousness in view of the reference evidence. Therefore we need not consider appellants' evidence of secondary considerations (Brief, pages 18-28).³ Accordingly, the examiner's rejection of claims 1, 5, 12 and 16 under section 103(a) over the admitted prior art in view of Jonsson is reversed.

C. Summary

The rejection of claims 2-4, 7, 9, 18 and 19 under the first paragraph of 35 U.S.C. § 112 is reversed.

The rejection of claims 1, 5, 12 and 16 under 35 U.S.C. § 103(a) over the admitted prior art of appellants' Figure 5 in view of Jonsson is reversed.

³We note that the examiner has failed to mention, much less consider, appellants' evidence of secondary considerations (see the Answer in its entirety). Similarly, the examiner has failed to address the separate arguments concerning dependent claims 12 and 16 (Brief, pages 28-29). However, these errors are moot in view of our decision *supra*.

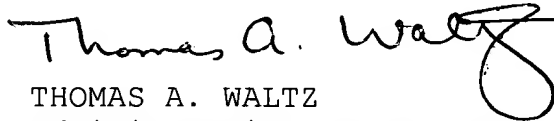
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The decision of the examiner is reversed.

REVERSED



CHARLES F. WARREN)
Administrative Patent Judge)



THOMAS A. WALTZ)
Administrative Patent Judge)



PETER F. KRATZ)
Administrative Patent Judge)

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